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10/697,031	10/31/2003	John Deryk Waters	300203673-2	1094

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EXAMINER	
GOLDBERG, BRIAN J	

ART UNIT	PAPER NUMBER
2861	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,031	WATERS, JOHN DERYK	
	Examiner	Art Unit	
	Brian Goldberg	2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-24* is/are rejected.

7)☒ Claim(s) *4* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10697031.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/02/04*. + 10/31/03
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Specification

1. The abstract of the disclosure is objected to because of undue length. The abstract is to be a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed "movement of the memory tag dispenser relative to the base medium is along a third axis substantially parallel to the first axis" does not meet the invention set forth in the specification. The third axis is described as moving perpendicular to the first axis, not parallel.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5-7, 9-17, 19, 20, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fox et al. (US Patent 6280544).

6. Regarding claim 1, Fox et al. disclose an "apparatus for printing and memory tag application onto a base medium (see fig 2), the apparatus having a print head (12 of fig 2) for printing onto the base medium (100 of fig 2), and a memory tag dispenser (34 of

fig 2) movable relative to the base medium for applying memory tags (110 of fig2) to the base medium." The tag supply on a roller (34) is a form of tag dispenser and it moves relative to the base medium.

7. Regarding claim 2, Fox et al. disclose "the print head (12 of fig 2) is movable relative to the base medium (col 6 ln 35-37)."

8. Regarding claim 3, Fox et al. disclose "the base medium (100 of fig 2) is moved along a first axis (from right to left of fig 2) through or past the apparatus and the print head (12 of fig 2) moves back and forth along a second axis (into and out of the page when looking at fig 2) and the memory tag dispenser (34 of fig 2) moves back and forth along a third axis (into and out of the page when looking at fig 2), the second and third axes being substantially perpendicular to the first axis." The tag dispenser (34) moves along the axis (clockwise or counter-clockwise) pointing into and out of the page (the z-axis) when looking at fig 2. The print head (12) and tag dispenser (34) move on an axis into and out of the page (the z-axis), which is perpendicular to the right-to-left axis (the x-axis) that the base medium moves along.

9. Regarding claim 5, Fox et al. disclose "the memory tag dispenser (34 of fig 2) includes a supply of memory tags (110 of fig 2) on a flexible substrate (118 of fig 2) and a substrate guide path (38 and 40 of fig 2) which takes the substrate past a memory tag application station (the area around 46 of fig 2) where memory tags (112 of fig 5) are removed from the substrate and applied to the base medium (occurs at 47 of fig 2) as required (col 7 ln 34-41).

10. Regarding claim 6, Fox et al. discloses "the memory tag application station includes a reciprocating member (54 of fig 2) adapted to apply pressure to the substrate opposite the location of a memory tag pushing the memory tag onto the base medium, thus transferring the memory tag from the substrate to the base medium (col 7 ln 53-56)."

11. Regarding claim 7, Fox et al. disclose "the memory tag dispenser further includes a data write station (44 of fig 2) where data is written to the memory tags and which is located such that the substrate passes it shortly before passing the memory tag application station." The substrate passes the data write station right before moving to the application station (represented as the area around 46 of fig 2).

12. Regarding claim 9, Fox et al. disclose "the memory tag dispenser further includes a data check station (56 of fig 2) which the memory tags pass after the data write station (44 of fig 2) and where the memory tags are read and the data checked with that written at the data write station (col 7 ln 58-61).

13. Regarding claim 10, Fox et al. disclose "the base medium (100 of fig 2) passes the print heas (12 of fig 2) before passing the memory tag dispenser (34 of fig 2)."

14. Regarding claim 11, Fox et al. disclose "it is adapted to handle base medium (100 of fig 2) in sheet form which passes through the apparatus." The label media (col 6 ln 23) is a sheet form.

15. Regarding claim 12, Fox et al. disclose "the base medium (100 of fig 2) passes through the apparatus with a surface towards the print head (12 of fig 2) and the memory tag dispenser (34 of fig 2), and the printing and the memory tag are applied to

that surface." In this case, the surface is the label and the printing and memory tag are both applied to the surface.

16. Regarding claim 13, Fox et al. disclose an "apparatus for printing and memory tag application onto a base medium (100 of fig 2), the apparatus having a print head (12 of fig 2) for printing onto the base medium, and a memory tag dispenser (34 of fig 2) movable relative to the base medium for applying memory tags to the base medium wherein the base medium is moved along a first axis (right-to-left axis of fig 2) through or past the apparatus, the print head does not move (col 6 ln 35-37), and the memory tag dispenser moves back and forth along a third axis (into and out of the page axis of fig 2) which is substantially perpendicular to the first axis." The tag dispenser (34) moves on an axis into and out of the page (the z-axis), which is perpendicular to the right to left axis (the x-axis) that the base medium moves along.

17. Regarding claim 14, Fox et al. disclose an "apparatus for printing and RFID tag (col 2 ln 35-40) application onto a base medium (100 of fig 2) in sheet form, the apparatus having a print head (12 of fig 2) for printing onto the base medium, and an RFID tag dispenser (34 of fig 2) movable relative to the base medium for applying RFID tags to the base medium, wherein the base medium is moved along a first axis (right-to-left axis of fig 2) through or past the apparatus, the print head moves back and forth (col 6 ln 35-37) along a second axis (into and out of the page axis of fig 2), and the RFID tag dispenser moves back and forth along a third axis (into and out of the page axis of fig 2), the second and third axes being substantially perpendicular to the first axis and parallel to each other." The print head (12) and tag dispenser (34) both move on an

axis into and out of the page (the z-axis), which is parallel by definition, and is perpendicular to the right-to-left axis (the x-axis) that the base medium moves along.

18. Regarding claim 15, Fox et al. disclose "a method of printing onto a base medium (100 of fig 2) and applying a memory tag (112 of fig 5) to the base medium comprising the steps of: i) feeding the base medium along a first axis (right-to-left axis of fig 2) past a print head (12 of fig 2); ii) printing onto the base medium (col 6 ln 38-41); iii) feeding the base medium past a memory tag dispenser (34 of fig 2), and iv) moving the memory tag dispenser relative to the base medium and applying a memory tag to the base medium at a desired location (at 47 of fig 2)."

19. Regarding claim 16, Fox et al. disclose "it further comprises the step of moving the print head (12 of fig 2) relative to the base medium (col 6 ln 35-37)."

20. Regarding claim 17, Fox et al. disclose "the movement of the print head (12 of fig 2) relative to the base medium is along a second axis (into and out of the page axis of fig 2) substantially perpendicular to the first axis (right-to-left axis of fig 2)." The first axis can be considered the x-axis while the second axis can be considered the z-axis. These axes are perpendicular, by definition.

21. Regarding claim 19, Fox et al. disclose "it further comprises the step of writing data to the memory tag, prior to applying it to the base medium (col 7 ln 26-28)."

22. Regarding claim 20, Fox et al. disclose "it further comprises the step of reading the data on the memory tag and checking it against the data written to it (col 7 ln 58-61)."

23. Regarding claim 23, Fox et al. disclose "a method of printing onto a base medium (100 of fig 2) and applying a memory tag (112 of fig 5) to the base medium comprising the steps of: i) feeding the base medium along a first axis (right-to-left axis of fig 2) past a print head (12 of fig 2); ii) moving the print head relative to the base medium (col 6 ln 35-37) along a second axis (into and out of the page axis of fig 2) substantially perpendicular to the first axis; iii) printing onto the base medium (col 6 ln 38-41); iv) feeding the base medium past a memory tag dispenser (34 of fig 2); v) moving the memory tag dispenser relative to the base medium along a third axis (into and out of the page axis of fig 2) substantially perpendicular to the first axis; and vi) applying a memory tag to the base medium at a desired location (47 of fig 2)." The first axis can be considered the x-axis while the second axis can be considered the z-axis. These axes are perpendicular, by definition.

24. Regarding claim 24, Fox et al. disclose "a method of printing onto a base medium in sheet form and applying an RFID tag (col 2 ln 35-40) to the base medium (100 of fig 2) comprising the steps of: i) feeding the base medium along a first axis (right-to-left axis of fig 2) past a print head (12 of fig 2); ii) moving the print head along a second axis (into and out of the page axis of fig 2) substantially perpendicular to the first axis; iii) printing onto the base medium (col 6 ln 38-41); iv) feeding the base medium past an RFID tag dispenser (34 of fig 2); v) moving the RFID tag dispenser along a third axis (into and out of the page axis of fig 2) substantially perpendicular to the first axis and substantially parallel to the second axis; and vi) applying an RFID tag to the base medium at a desired location (47 of fig 2)." The print head (12) and tag dispenser (34)

(into and out of the page axis of fig 2) substantially perpendicular to the first axis and substantially parallel to the second axis; and vi) applying an RFID tag to the base medium at a desired location (47 of fig 2)." The print head (12) and tag dispenser (34) both move on an axis into and out of the page (the z-axis), which is parallel by definition, and is perpendicular to the right-to-left axis (the x-axis) that the base medium moves along.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

27. Claims 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. in view of Austin et al. (US Patent 6645327).

28. Regarding claim 8, Fox et al. disclose the claimed invention as set forth above with respect to claims 1, 5 and 7. Thus, Fox et al. meet the claimed invention except "the data write station also reads the memory tags after writing to them to check that the data has written correctly."

29. Austin et al. teach providing a "data write station (240 of fig 12) [that] also reads the memory tags after writing to them to check that the data has written correctly (col 12 ln 53-55)." It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to provide a "data write station [that] also reads the memory tags after writing to them to check that the data has written correctly." One would have

been motivated to so modify Fox et al. for the benefit of reducing the number of parts, to allow for easier manufacturing, by making the data write and data read take place at the same location instead of at two separate locations.

30. Regarding claim 21, Fox et al. disclose the claimed invention as set forth above with respect to claim 15. Fox et al. further disclose "the memory tag (112 of fig 5) is applied to the base medium (100 of fig 2)." Thus, Fox et al. meet the claimed invention except "at a location printed with a preselected icon."

31. Hohberger et al. teach providing a printed preselected icon (248 of fig 18) at a location where the memory tag is applied. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to apply the memory tag to the base medium "at a location printed with a preselected icon." One would have been motivated to so modify Fox et al. for the benefit of enhancing the aesthetic appearance of the base medium and to have a uniform memory tag location for a set of base medium.

Allowable Subject Matter

32. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goldberg whose telephone number is 571-272-2728. The examiner can normally be reached on Monday through Friday, 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Gray can be reached on 571-272-2119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BJG

RENEE LUEBKE
PRIMARY EXAMINER